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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COONEY, JOHN M

ART UNIT

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1796

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,428

Applicant(s)

SYMONS, MICHAEL WINDSOR

Examiner

John Cooney

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-25, 28-34 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-25, 28-34 and 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's arguments filed 10-21-08 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-25, 28-34 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurz et al.(3,451,842) in view of Van Oost(5,931,595).

Kurz et al. discloses methods for manufacturing an impregnated open celled polymeric foamed article wherein a binder solution as claimed is administer and impregnated into the foam through the action of rollers and pressing followed by setting and drying (see the examples, as well as, the entire document). Additionally, shaping, molding, and/or pressing are operations provided for by the teachings of Kurz et al. (see column 1 lines 60-66). Though not specifically highlighted, the densities of applicants' claims are held to be elements readily envisioned from the disclosed teaching of open celled articles provided for by Kurz et al. Additionally, employment of multiple rollers for purpose of providing the rolling operations disclosed is held to be an operation readily envisioned from the teachings of Kurz et al. based on Kurz et al.'s encompassing disclosure of rolling.

Kurz et al. differs from applicants' claims in that it does not require feeding of the setting slurry through at least one of the rolling apparatuses. However, Van Oost (see the entire document) discloses devices for applying liquid products through perforated rollers for the purpose of providing controlled administration of the applied solution. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the roller device of Van Oost in applying the binder solution to the open cell article in the preparations of Kurz et al. for the purpose of controlling administration of the binder slurry, providing conservation of administered product, and promoting cleaner administration of the administered material in order to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

The combination of Kurz et al. and Van Oost differs in that perforated multiple rollers are not employed. However, the combination is clear in its disclosure of employment of rollers and administering materials therethrough, and it has been held by the court that the mere duplication of parts has no patentable significance unless a new or unexpected result is produced. (See *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), as well as, M.P.E.P. 2144.04 VI. B.) Accordingly, it would have been obvious for one having ordinary skill in the art to have multiplied the perforated roller embodiment provided for by the combination of Kurz et al. and Van Oost in order to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicants' latest arguments have been considered. However, rejection is maintained.

The following arguments are maintained:

Applicants' claims do not distinguish over the permeable rollers of the prior art in the patentable sense based on the term "perforated". Both relate to holes for passage of liquid. Applicants' claims further do not distinguish over the prior art based on the degrees of compression defined by the claims. Degrees of compression are not defined by the claims which would distinguish over the degrees identified by the prior art.

As to duplication of the rolling element/effect, it has long been held that duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Unexpected results based on this feature are not seen nor has it been demonstrated.

As to applicants' argument that the secondary teaching is not analogous art, it is held that the determination that a reference is from a non-analogous art is twofold. First, it is decided if the reference is within the field of inventor's endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which inventor was involved. *In re Wood*, 202 USPQ 171, 174; *In re Clay*, 23 USPQ.2d 1058. {see also *In re Bigio*, 381 F.3d 1320, 72 USPQ2d 1209 (Fed. Cir. 2004) and M.P.E.P. 2141.01(a)}. The secondary teaching is maintained to be analogous art. Paint is a binder, and the teachings of this secondary teaching are at least reasonably pertinent to the particular problem with which inventor was involved.

Applicants' arguments pertaining to their showings of results have been considered. However, the assertions of results have not been demonstrated in fact and/or shown to be commensurate in scope with the scope of the claims as they currently stand.

Applicants' claims 29-34 have been considered based on the teachings of the combination of the prior art. However, the prior art is seen to provide rollers having a solid core component which is stationary to the degree required by the claims. Feed conduits are provided by the disclosures of the prior art to the degrees required by the claims as well as the means for delivering the binder to perforated/permeable surface of the roller. Other elements of the new claims are addressed in the arguments above.

Rejection does not fail because of the failures of the testing indicated in applicants' reply. These failed tests do not substitute for the required commensurate in scope showing of new or unexpected results attributable to differences in applicants' claims. Additionally, applicants' assertion of effects associated with their process operations does not substitute for a fact based showing of new or unexpected results attributable to differences in applicants' claims.

As to the make-up of the permeable cylinder of the secondary teaching, it is held and maintained that this permeable cylinder is a perforated roller to the degree required by applicants' claims.

Distinction in applicants' invention based on the meaning of the low viscosity paint of Van Oost versus the slurry of Kurz et al. is not seen. From the standpoint of patentability, Van Oost provides means for administering flowable material which is properly combined with Kurz et al. Distinction in terminology used in defining the flowable materials is not sufficient demonstration of the failure of these combined teachings. The combinations of the above prior art are maintained to be properly combined and analogous art for the reasons set forth above.

That the teaching of Van Oost may have other value, such as uniformly distributing the flowable mixture on the roller, does not negate its applicability in the combination set forth above. Additionally, it is the primary reference that identifies impregnating the rolled article, this is not a feature lacking from the primary, Kurz et al., teaching.

Applicants' latest arguments have been considered. However, rejection is maintained for the reasons set forth above.

Applicants' declarative evidence and showings and arguments as to distinction over the prior art based on the perforated rollers as claimed by applicants have been considered but are unpersuasive. Applicants' claims are not limited to the perforations discussed in the response and filed declarations. Similarly, the results identified in the response and the provided declarative evidence do not demonstrate unexpected results attributed to perforated roller systems that are commensurate in scope with the claims as they currently stand. Accordingly, the showings presented are insufficient in showing new or unexpected results commensurate in scope with the claims sufficient to overcome the rejection.

The showings are additionally insufficient in demonstrating the rejection to fail, because it is not seen that the perforated roller(s) as defined by applicants' claims

distinguish over the rollers provided for by the teachings of the combined prior art. The claims do not set forth degrees of perforation sufficient to distinguish over the perforations/passageways provided for by the combined teachings of the cited prior art. Further, from the standpoint of patentability, difference in how perforations/passageways are formed are not patentable unless difference in the claims is demonstrated over the perforations/passageways of the cited prior art. Currently, difference in the perforations of applicants' claims over the passageways provided for by the teachings of the combined prior is not seen to be evident. Furthermore, even if the sheathing/covering material on the roller were distinguished from the perforations as defined by applicants' claims, it is held that the limitations of applicants' claims do not exclude this additional sheathing/covering material of Van Oost.

Applicants' discussion and declarative evidence pertaining to difficulties arising from attempts to practice a combination of the teachings of the cited prior art do not substitute of are factually supported showing of new or unexpected results that are commensurate in scope with the claims. Applicants' arguments and evidence of results are not demonstrated to be associated with differences supported by limitations in the claims.

The following need to be considered when considering submissions of comparative evidence:

Results Must be Unexpected:

Unexpected properties must be more significant than expected properties to rebut a prima facie case of obviousness. *In re Nolan* 193 USPQ 641 CCPA 1977.

Obviousness does not require absolute predictability. *In re Miegel* 159 USPQ 716.

Since unexpected results are by definition unpredictable, evidence presented in comparative showings must be clear and convincing. *In re Lohr* 137 USPQ 548.

In determining patentability, the weight of the actual evidence of unobviousness presented must be balanced against the weight of obviousness of record. *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *In re Beattie*, 24 USPQ 2d 1040.

Claims Must be Commensurate With Showings:

Evidence of superiority must pertain to the full extent of the subject matter being claimed. *In re Ackerman*, 170 USPQ 340; *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *Ex Parte A*, 17 USPQ 2d 1719; accordingly, it has been held that to overcome a reasonable case of prima facie obviousness a given claim must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197 USPQ 227. Further, a limited showing of criticality is insufficient to support a broadly claimed range. *In re Lemin*, 161 USPQ 288. See also *In re Kulling*, 14 USPQ 2d 1056.

Applicants' have not persuasively demonstrated unexpected results for the combinations of their claims. Applicants' have not demonstrated their showing to be commensurate in scope with the scope of combinations now claimed. Applicants have not demonstrated factually supported results identified to be associated with differences reflected in their claims that are commensurate in scope with the scope of their claims.

Applicants' arguments that the combined prior art is not combinable are unpersuasive and maintained to be rebutted in examiner's previous arguments set forth again above. Van Oost is at least pertinent to the particular problem which inventor was involved in that it provides a means for administering flowable material for application to a surface in a cleaner and more controllable fashion. Again, it is the primary reference that identifies impregnating the rolled article, this is not a feature lacking from the primary, Kurz et al., teaching. The secondary reference is only looked to for its disclosure of using the roller as a source of the liquid for impregnation.

As to applicants' new claims pertaining to further details in ranges of density values for the foams and products of their claims. It is held and maintained that such a feature is a variable readily envisioned by one of ordinary skill in the art, and higher densities of impregnated formed articles is an effect intrinsically arising from filling the voids of the foam material. Accordingly, difference based on the density of the foam material employed and final product formed is not seen to be evident in the instant case. Further, even if difference were evident based on densities of materials employed, it is held that it would have been obvious for one having ordinary skill in the art to have varied the amounts water and/or other blowing agents used in the making of the foams of Kurz et al. for use within the preparations of Kurz et al. for the purpose of controlling the density and structural effects of the formed polymer material to be filled in order to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Further, varying the degree of filling of the pores in the filling of the foam within the operations provided for by the

teachings of the prior art for purposes of obtaining articles of varied strengths and weights would have been within the purview of the ordinary practitioner art with the expectation of success in the absence of a showing of new or unexpected results.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Anorga(4,315,078) & Dwyer et al.(3,441,523) are cited their disclosure of the well known effects of additives, water, and other blowing agents on the physical properties, including density in polyurethane foams manufacture. Findley et al.(2,591,530) & Clief, Jr.(2,753,577) are cited for their disclosures of perforated rollers used in applying liquid compositions to surfaces.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/

Primary Examiner, Art Unit 1796